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EXAMINER

REAGAN, JAMES A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,797

Applicant(s)

TAGAWA ET AL.

Examiner

James A. Reagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 20, and 25-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in response to the Amendment and RCE filed on 07 October 2005.
2. Claims 1, 10, and 20 have been amended.
3. Claims 2-9, 11-19, and 21-24 have been canceled.
4. Claims 25-33 have been added.
5. Claims 1, 10, 20, and 25-33 are currently pending and have been examined.
6. The rejections of claims 1, 10, and 20 have been updated to reflect amended limitations.
7. The rejections of claims 25-33 are original.

RESPONSE TO ARGUMENTS

8. Applicant's arguments received on 07 October 2005 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1 and 25-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and the Examiner therefore will treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prince, "Online Auctions at eBay" (c) 21 April 1999, in view of Ogilvie (US 6,343,738 B1).

Claims 1, 10, and 20:

Prince, in at least pages 97-102 discloses the registration of a new member. In addition, Prince on pages 121-132 also discloses a bidding process in an online shopping and auction format, wherein a user is required to log in and provide a password after proper registration. Prince also shows summary information regarding the product up for bid by the buyer. After properly registering and bidding, the user may see the detailed information about the product and its bidding history. Except as noted below, Prince therefore discloses the following limitations:

- *a summary information disclosing function for disclosing summary information of the medical instrument product via the internet*
- *a registration requesting function for requesting a user who reads the summary information disclosed by the summary information disclosing function to register as a member if the user desires detailed information about the product;*
- *a registration function for registering the user as a member, the registration function requires the user to send user data at the registering; and*

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- *a detailed information disclosing function for allowing the registered user to access the detailed information about the product,*
- *wherein the user data required by the registration function is used for selection of a proper user in later activities for medical instrument sales activities.*

Prince does not disclose that the items up for auction are specifically medical instruments. Ogilvie, however, in at least column 1, line 66 to column 2, line 14 as well as other associated and relevant text discloses that e-commerce web sites provide for online purchases that would include medical devices. It would have been obvious to one of ordinary skill in the art at the time of the invention to add Ogilvie's feature of online sale of medical equipment to Prince's online auction system because, "...transactions involving goods other than software can also be performed using software sales "personnel". Auction sites such as www.ebay.com facilitate transactions involving software and many other types of goods, both digital and non-digital. Reverse auction or "demand collection" sites such as www.priceline.com facilitate transactions involving both goods and services" (Ogilvie: column 1, lines 59-65). Since Prince discloses online auctions at eBay, disclosure of eBay items is analogous as well as relevant.

Claims 25-33:

Prince, as shown above, discloses the online registration process for viewing and participating in online auctions, intrinsically disclosing that information concerning an auction or auction item is sent only to registered users i.e. those buyers who have voluntarily submitted proper contact information such as name, address email, etc and other demographic data. Prince therefore discloses the following limitations:

- *a member limitation function for limiting member users to whom information of a medical instrument is sent based on the registered user data;*
- *an information sending function for sending the information of the medical instrument to the users limited by the member limitation function by e-mail;*
- *the member limitation function uses at least data of each user's section*

included in the registered user data for limitation;

Prince does not disclose that demographic and user data specifically consists of user's level, position, career record, or geographical region, and therefore does not specifically disclose *the member limitation function uses at least one of data selected from each user's level, position, career record, and geographical region.* However, the Examiner takes **Official Notice** that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize voluntarily submitted demographic data not only to ensure proper delivery of auctions item(s) but also to provide a standard degree of security concerning the proper identification and identify of parties involved in the online transactions.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

571-273-8300 [Official communications, After Final communications labeled "Box AF"]

571-273-8300 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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401 Dulany Street

Alexandria, VA 22314.

JAMES A. REAGAN

Primary Examiner

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02 November 2005

